

REMARKS

The Office Action dated January 8, 2009, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Status of the Claims

Claims 1, 7, 21, 27, 29-31, 42, 46, 50 and 51 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Support for the amendments is found, for example, in Fig. 5, on page 14, lines 12-22, and on page 16, line 5, through page 17, line 5, of the present application. No new matter has been added. Claim 20 has been cancelled without prejudice or disclaimer. Thus, claims 1-21, 27 and 29-51 are currently pending in the application and are respectfully submitted for consideration.

Rejection under 35 U.S.C. § 112

On page 3, the Office Action rejected claims 50 and 51 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleged that “[c]laims 50 and 51 recite a ‘computer program embodied on a computer-readable medium,’ however such a program and/or software embodied on a computer readable medium is not taught, suggested or disclosed in Applicant’s specification.” Applicant respectfully traverses the rejection.

To satisfy the written description requirement of the first paragraph of 35 U.S.C. § 112, a disclosure need only describe a claimed invention in a manner sufficient to

reasonably convey to those skilled in the relevant art that Applicant was in possession of the claimed invention at the time the application was filed (see MPEP § 2163). This possession may be shown in any number of ways and Applicant **need not describe every claim feature exactly** (see *Id.*). Rather, all that is required is “reasonable clarity”.

First, Applicant submits that reasonable clarity is present here. The present specification discusses a wireless communication system including, for instance, user equipment and network nodes. As is commonly understood, the hardware devices in such communication systems generally contain software and store the software in memory. In the present case, the Office Action appeared to allege that because the specific phrases “program” and/or “software embodied on a computer-readable medium” do not appear in the specification, a person of ordinary skill in the art (POSA) allegedly would not understand a software implementation to have been included in the present specification. However, this antecedent basis-type approach is not the appropriate test, per the above.

Also, in modern networking systems, Applicant submits that it is untenable to hold the position that a person of ordinary skill in the art would not understand that the service features of such a system may be performed by software, and further that software is generally stored on some storage medium readable by a computer. For instance, Applicant submits that it would be rather difficult to find a person who did not believe that their cell phone operated with the aid of software and memory, let alone such a person of ordinary skill in the art of network communications. Further, the present

specification discusses on page 2 that “SIP is an application layer signalling protocol for starting, changing and ending user sessions” (see lines 18 and 19) and network applications are most commonly realized via software.

Second, the Office Action has not set forth express findings of fact for an alleged lack of support for a computer program embodied on a computer-readable medium. As such, the Office Action failed to make a *prima facie* case. According to MPEP 2163.04(I), an Office Action must:

(A) Identify the claim limitation(s) at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

In the instant case, the Office Action merely asserted that the present specification does not disclose, teach or suggest a computer program embodied on a computer-readable medium without providing any reasoning as to why the present specification allegedly lacks reasonable clarity from the perspective of a person of ordinary skill in the art with respect to these features. This conclusory statement is insufficient to satisfy the requirements for establishing a *prima facie* case as dictated by MPEP § 2163.04(I).

Third, the written description rejection under 35 U.S.C. § 112, first paragraph, and the obviousness rejections under 35 U.S.C. § 103 present incompatible, and antithetical, levels of skill for a person of ordinary skill in the art. With respect to the rejection under 35 U.S.C. § 112, the Office Action has applied a person of ordinary skill who would not

understand from the discussion of a network system in the present specification, including architectural and signaling diagrams, that some embodiments of the present invention may be realized via software embodied on a computer-readable medium. On the other hand, the rejections under 35 U.S.C. § 103 employ a person who is allegedly able to understand, combine and apply various disparate communications patents to allegedly achieve the features recited in the claims. These are two different standards of skill that cannot be resolved in the same Action. If the rejection under 35 U.S.C. § 112, first paragraph, were to be maintained (which is clearly improper), the rejections under 35 U.S.C. § 103 would all have to be withdrawn as these cannot exist in the same Office Action with the written description rejection.

Fourth, Applicant notes that filling a specification with every known variant for every claimed feature would be unduly burdensome and would further considerably lengthen the specification in many cases. U.S. patent law does not request a discussion of that which is already known. Rather, the impetus is on describing embodiments of an invention from the starting point of what would be understood by one of ordinary skill in the art. Accordingly, a designation of which specific “media” and “programs” the claimed invention refers to is neither required nor necessarily desirable under U.S. patent practice.

Fifth, even if a written description rejection is appropriate here, which is not admitted and is further clearly and explicitly not the case per the above, the failure to bring forth such a rejection at the earliest possible opportunity violates the USPTO’s

stated policy of compact prosecution. This policy requires that an Examiner should provide a rejection at the earliest possible opportunity during prosecution. The goal of this judicious policy is to shorten the duration of patent prosecution as much as possible. In the present case, software claims 50 and 51 were introduced in the Response filed May 21, 2008, and any applicable rejections should have been presented in the following Office Action dated July 31, 2008. As such, the outstanding Office Action is tardy in the application of a non-art-based rejection to these claims. Applicant notes that any further non-art-based rejections of these claims would also violate this policy.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1, 3, 4, 6-14, 16-18, 20, 21, 27, 29-32, 34, 36-38, 40, 42, 43, 46, 47, 50 and 51 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chavez et al. (U.S. Patent No. 6,591,102) in view of Lamb (U.S. Patent No. 6,085,083) and further in view of Bilgic et al. (U.S. Patent No. 6,097,817). While claim 18 was not listed in the heading of the rejection, it is mentioned in the body thereof. Also, while claim 33 was listed in the heading of the rejection, it was not discussed in the body thereof. The Office Action took the position on pages 4-27 that the combination of Chavez et al., Lamb and Bilgic et al. teaches all of the features of the rejected claims. Applicant respectfully submits that Chavez et al., Lamb and Bilgic et al., both individually and in

combination, fail to teach or suggest all of the features of the above-rejected claims.

Reconsideration of the claims is respectfully requested.

Independent claim 1, from which claims 2-6 depend, recites a method including using a specific record associated with a user. The specific record is stored at a server node. The specific record contains information that determines that a user characteristic is to be verified with a home network prior to providing access to the service. Authorization and authentication for the user is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 7, from which claims 8-19 depend, recites a method including using a user specific record associated with a user. The user specific record is stored in a server node that indicates a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing access to a service. The method also includes providing access to the service responsive to the user specific record. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 21 recites an apparatus including receiving means for receiving a message from a user terminal and storing means for storing a user specific record associated with a user indicating a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with access to a service. The apparatus also includes generating means for generating, in response to the user specific record, an access message to provide the user with access to

the service from a service provider node. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 27 recites an apparatus including record using means for using a user specific record associated with a user indicating a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with access to a service. The user specific record is stored in a server node. The apparatus also includes generating means for generating, in response to the user specific record, an access message for providing the user with access to the service from a service provider node. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 29 recites a method including storing an authorization and authentication profile, associated with a user. The authorization and authentication profile is stored at a serving node in a serving network. The method also includes using the authorization and authentication profile at the serving node. The authorization and authentication profile contains information indicating a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing access to the service. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 30, from which claims 32-36 depend, recites an apparatus including an interface configured to receive a message from a user terminal and a

processor configured to use a user specific record associated with the user to indicate a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with access to a service. The user specific record is stored in a server node. The processor is also configured to generate, in response to the user specific record, an access message to provide the user with access to the service from a service provider node. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 31, from which claims 37-41 depend, recites an apparatus including a processor configured to use a user specific record associated with a user to indicate a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with access to a service. The user specific record is stored in a server node. The processor is also configured to generate, in response to the user specific record, an access message to provide the user with access to the service from a service provider node. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 42, from which claims 43-45 depend, recites a method including receiving a message from a user terminal and using a user specific record associated with the user indicating a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with

access to a service. The user specific record is stored in a server node. The method also includes generating, in response to the user specific record, an access message providing the user with access to the service from a service provider node. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 46, from which claims 47-49 depend, recites a method including using a user specific record associated with a user indicating a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with access to a service. The user specific record is stored in a server node. The method also includes generating, in response to the user specific record, an access message providing the user with access to the service from a service provider node. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 50 recites a computer program embodied on a computer-readable storage medium configured to control a processor to perform a process, including receiving a message from a user terminal and using a user specific record associated with a user indicating a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with access to a service. The user specific record is stored in a server node. The process also includes generating, in response to the user specific record, an access message providing the user with access to the service from a service provider node. The condition is that

authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

Independent claim 51 recites a computer program embodied on a computer-readable storage medium configured to control a processor to perform a process, including using a user specific record associated with a user indicating a condition that, when satisfied, determines that a user characteristic is to be verified with a home network prior to providing the user with access to a service. The user specific record is stored in a server node. The process also includes generating, in response to the user specific record, an access message providing the user with access to the service from a service provider node. The condition is that authorization and authentication is verified when the number of simultaneous sessions is equal to a predetermined number.

As will be discussed below, Chavez et al., Lamb and Bilgic et al., both individually and in combination, fail to teach or suggest all of the features of the presently pending claims.

Chavez et al. generally discusses “a system for transmitting service and authentication information in a manner that [allegedly] reduces transmissions over the system” (column 1, lines 8-10). “The amount of data is [allegedly] reduced by only transmitting the service information for a handset to a base station when the handset registers with a base station. Authentication information is only transmitted to the base station when a request for a wireless service is requested for the wireless handset” (column 2, lines 4-7, of Chavez et al.).

Lamb generally discusses a “home location register (HLR) that provides fraud protection mediation in a wireless communication network” (column 1, lines 44 and 45). “[A] carrier may have the HLR bypass the fraud protection processing in areas that support authentication processing to provide convenience to the subscribers so that they do not have to enter their PINs to use their cellular phones” (column 3, lines 55-59, of Lamb).

Bilgic et al. generally discusses “techniques for providing security in a wireless communication system” (column 1, lines 9 and 10).

[A] wireless access communication unit is provided which has multiple trunk interfaces for connection to a CPE, and a radio transceiver for establishing one or more wireless communication links to a cellular network. Each trunk interface is connected to a line card comprising a vocoder and a subscriber interface. A controller interfaces the line cards with the radio transceiver, and assists in the conversion of data from a format suitable for wireless transmission to a format suitable for transmission over the CPE trunk, and vice versa. Data communicated between the wireless access communication unit and the network may be encrypted at the wireless access communication unit and decrypted at the mobile switching center or else at a separate transcoding unit interposed between the mobile switching center and the base station subsystem.

(Column 2, lines 31-45, of Bilgic et al.).

Independent claim 1 recites, in part, that “authorization and authentication for the user is verified when the number of simultaneous sessions is equal to a predetermined number.” Independent claims 7, 21, 27, 29-31, 42, 46, 50 and 51, which each have their own scope, recite similar features. The Office Action conceded on page 6 that Chavez et al. and Lamb do not “disclose that the user is verified every Mth session.” Instead, the

Office Action relied on column 30, line 14, through column 31, line 30, of Bilgic et al. to allegedly cure these deficiencies of Chavez et al. and Lamb. Specifically, the Office Action asserted on page 6 that “[i]n the same field of endeavor, Bilgic et al. clearly show and disclose authentication is performed with each user registration, as well as part of normal call setup on a 1-in-N basis--i.e., once every N calls authentication is performed, with N being configurable within the system”. Applicant respectfully submits that Bilgic et al. also fails to teach or suggest the above-recited features of claim 1.

The cited section of Bilgic et al. discusses that “in many analog mobile telephone networks mobile telephones can be cloned, causing large amounts of revenue to be lost due to illegal use of such telephones” (see column 30, lines 19-21). “Authentication is preferably performed with each user registration, as well as part of normal call setup on a 1-in-N basis--i.e., once every N calls authentication is performed, with N being configurable within the system” (column 30, lines 27-31, of Bilgic et al.). In other words, once out of every N calls, the system in Bilgic et al. may perform authentication. However, independent claim 1 recites that authentication and authorization for the user is verified when the number of **simultaneous sessions** is equal to a predetermined number. On the other hand, in Bilgic et al., N is constant unless configured and represents a number of **calls** that are not occurring at once (*i.e.*, consecutive calls). Thus, Bilgic et al. is not capable of achieving the features recited in independent claim 1.

Claims 3, 4, 6, 8-14, 16-18, 20, 34, 36-38, 40, 43 and 47 depend from independent claims 1, 7, 30, 31, 42 or 46 and add further features thereto. Thus, the arguments above with respect to the independent claims also apply to the dependent claims.

Per the above, Chavez et al., Lamb and Bilgic et al., both individually and in combination, fail to teach or suggest all of the features of the above-rejected claims under 35 U.S.C. § 103(a). Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

Claims 2, 5, 33, 39, 44 and 48 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chavez et al. and Lamb in view of Bilgic et al. and further in view of Henry et al. (U.S. Patent No. 6,856,800). Claims 2, 5, 33, 39, 44 and 48 depend from claims 1, 31, 42 or 46 and add further features thereto. Nothing is cited or found in Henry et al., which generally discusses “an authentication and access control system for [allegedly] reducing the time required for a mobile user to authenticate to a new communications network” (column 1, lines 13-16), that overcomes the deficiencies of Chavez et al., Lamb and Bilgic et al. discussed above with respect to the independent claims. Thus, the arguments above with respect to the independent claims also apply to dependent claims 2, 5, 33, 39, 44 and 48.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chavez et al. and Lamb in view of Bilgic et al. and further in view of Wright (U.S. Patent

No. 6,957,061). Claim 19 depends from independent claim 7 and adds further features thereto. Nothing is cited or found in Wright, which generally discusses “a method and apparatus for authenticating mobile user equipment in a mobile telecommunications network” (column 1, lines 6-8), that overcomes the deficiencies of Chavez et al., Lamb and Bilgic et al. discussed above with respect to the independent claims. Thus, the arguments above with respect to the independent claims also apply to claim 19.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

Claims 15, 35, 41, 45 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chavez et al. and Lamb in view of Bilgic et al. and further in view of Basilier et al. (U.S. Patent No. 6,728,536). Claims 15, 35, 41, 45 and 49 depend from independent claims 7, 31, 42 or 46 and add further features thereto. Nothing is cited or found in Basilier et al., which generally discusses “a method and system for transmitting access specific and/or application specific information from a visiting access network to a home network using public internet protocol networks” (column 1, lines 11-14), that overcomes the deficiencies of Chavez et al., Lamb and Bilgic et al. discussed above with respect to the independent claims. Thus, the arguments above with respect to the independent claims also apply to claims 15, 35, 41, 45 and 49.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

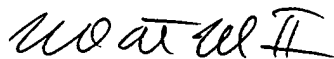
Conclusion

For at least the reasons presented above, it is respectfully submitted that claims 1-21, 27 and 29-51, comprising all of the currently pending claims, patentably distinguish over the cited art. Accordingly, it is respectfully requested that the claims be allowed and the application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



Michael A. Leonard II
Attorney for Applicant
Registration No. 60,180

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Vienna, Virginia 22182-6212
Telephone: 703-720-7800
Fax: 703-720-7802
MAL:jf